

Remarks

Claims 1-8, 10-18, 20-23, and 25-27 are pending. Claims 1-8, 10-18, 20-23, and 25-27 are rejected. Applicants respectfully traverse the rejection and request allowance of claims 1-8, 10-18, 20-23, and 25-27.

The objection to claims 1-8, 10-18, 20-23, and 25-27 was maintained. The inclusion of the wording “We claim” on the last page of the specification, and not on the first page of the claims, was objected to. The specification and claims are amended herein to overcome the objection.

Claims 1-8, 10-18, 20-23, and 25-27 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent 5,948,061 (Merriman et al.) in view of U.S. Patent 6,357,042 (Srinivasan et al.) and U.S. Patent 6,006,265 (Rangan et al.). The rejection has been maintained in an Advisory Action that follows a Response by Applicant to the outstanding final Office Action.

Claims 1, 12, and 22 require disabling fast-forward capability when the selected video advertising is displayed.

Neither Merriman nor Srinivasan teach or suggest disabling a fast-forward capability when the selected video advertising is displayed.

Rangan only teaches that users fast-forward through overt commercials (see col. 13, lines 10-13) and that a VCR appliance can include a fast-forward function (see col. 26, lines 37-39). The ability to fast-forward through commercials is distinctly different from the ability to disable this feature. Thus, the ability to disable fast-forwarding is not obvious from the ability to fast-forward.

The Supreme Court has set the standard for obviousness as comprising a three-part test, with the test comprising: 1) determining the scope and content of the prior art, 2) ascertaining the differences between the prior art and the claims at issue, and 3) resolving the level of ordinary skill in the pertinent art, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). This is still the standard of obviousness used today.

The inference of a fast-forward disabling feature from a VCR and from the ability to fast-forward a VCR through recorded commercials is improper. It is not a “reasonable

inference" to infer a fast-forward disable feature from the mere existence of a fast-forwarding capability. The obviousness standard would be meaningless if disclosed features could be used to infer any other features needed to make an obviousness rejection. Not only is the inference unreasonable, but Applicant fails to see how a VCR could be configured or constructed to not only recognize a commercial, but also to disable fast-forwarding during the commercial.

Independent claims 1, 12, and 22 therefore include features that are neither taught nor suggested by any of the cited references. Claims 2-8, 10-11, 13-18, 20-21, 23, and 25-27 depend from claims 1, 12, and 22, and are patentable for at least the reasons given above.

Applicants submit that there are numerous additional reasons in support of patentability, but that such reasons are moot in light of the above remarks and are omitted in the interests of brevity. Applicants respectfully request allowance of claims 1-8, 10-18, 20-23, and 25-27.

Please feel free to call me to discuss the patentability of claims 1-8, 10-18, 20-23, and 25-27.

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SIGNATURE OF PRACTITIONER

Gregg Jansen, Reg. No. 46,799
Duft Setter Ollila & Bornsen LLC
Telephone: (303) 938-9999 ext. 14
Facsimile: (303) 938-9995

Correspondence address:

CUSTOMER NO. 028004

Harley R. Ball
Sprint Law Department
6391 Sprint Parkway
Mailstop: KSOPHT0101-Z2100
Overland Park, KS 66251-2100